

REMARKS

Status of the claims:

With the above amendments, claims 4 and 6 are canceled, claims 21-38 are added, claims 1, 7, 17, 18, and 20 are amended, and claims 1-3, 5, and 7-38 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 1 can be found at canceled claim 4 and support for new claims 21-38 can be found in the written description and claims as originally filed. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Suzuki '488 (US Patent No. 6,612,488). Applicant traverses.

Suzuki '488 cannot anticipate the instantly claimed invention because Suzuki '488 fails to disclose all of the elements of claim 1 and claims dependent therefrom. For example, Suzuki '488 fails to disclose an identification document that is one or more members selected from the group consisting of a driver's license, a passport, a green card, a state issue identification card, and a federal identification card. As a matter of fact, Suzuki '488 fails to mention any of these types of these identification cards. For this reason alone, Suzuki '488 cannot anticipate the instant invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 4-20 are rejected under 35 U.S.C. 103(a) as allegedly being anticipated by Suzuki ‘488 in view of Terranova ‘464 (US Patent No. 6,422,464). Applicant traverses.

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, the Examiner has failed to show criteria 3) that the prior art reference (or references when combined) teach or suggest all the claim limitations.

Suzuki ‘488 and Terranova ‘464 both fail to disclose an identification document that is one or more members selected from the group consisting of a driver’s license, a passport, a green card, a state issue identification card, and a federal identification card as claimed in claims 1 and 20. Moreover, neither Suzuki ‘488 nor Terranova ‘464 remotely disclose that an identification document can be selected from the group consisting of a driver’s license, a passport, a green card, a state issue identification card, and a federal identification card as claimed in claims 1 and 20. Accordingly, all

claims that are dependent from claim 1 (and claim 20) cannot be rendered obvious by the combination of Suzuki '488 and Terranova '464. For this reason, the rejection over claim 5 is inapposite. Withdrawal of the rejection with respect to claim 5 is warranted and respectfully requested.

With respect to claims 7 and 17, Applicants submit that neither Suzuki '488 nor Terranova '464 disclose or remotely suggest an identification document that is unusable for payment as claimed in those claims. Both Suzuki '488 and Terranova '464 disclose the use of credit cards and/or debit cards in the retail environment. In this regard, Suzuki '488 states at column 3, lines 45-59:

. . . the present invention provides a method of authorizing credit/debit card transactions, using a card transaction terminal in a credit card member store, comprising the steps of: storing location information of said card transaction terminal in a database capable of being accessed by a host computer to which said card transaction terminal is connectable; sending information relating to said credit transaction payment from said card transaction terminal to a portable communication terminal containing information relating to the identity of said credit card user; inputting information relating to the current location of said portable communication terminal to said host computer; and recognizing said credit card user as the authentic cardholder when said location of said portable communication terminal is within a predetermined range from of said card transaction terminal.

From the above passage, it should be apparent that Suzuki '488 discloses and only contemplates using credit cards or debit cards in the retail environment. Nowhere in Suzuki '488 is there any disclosure or suggestion that an identification card can be used that is unusable for payment.

Terranova '464 fails to make up for the deficiencies of Suzuki '488. In this regard, Terranova '464, at column 7, lines 22-35 recites:

The dispenser 18 is preferably equipped with a payment acceptor, such as a card reader 88 or cash acceptor 90, along with a receipt printer 92. With these options, the dispenser control system 80 may read data from the magnetic strip of a card inserted in the card reader 88 or receive cash from a customer and communicate such information to the central control system 50 (as shown in FIG. 1), such as the G-site controller sold by Gilbarco Inc., 7300 West Friendly Avenue, Greensboro, N.C. The central control system 50 typically communicates with a remote network 94, such as a card verification authority, to ascertain whether a transaction proposed to be charged to or debited from an account associated with the card inserted in the card reader 88 is authorized.

From the above passage, it should be apparent that Terranova '464 discloses a card that allows for payment but fails to disclose or suggest an identification card that is unusable for payment. In other words, Terranova '464 only discloses cards that can be read that are usable for payment.

This is further apparent at column 38, lines 24-42 of Terranova '464 wherein the use of a credit card is described. This passage recites:

The present invention allows a customer to pre-select which types of information he wishes to access at a fuel dispenser station or other station. With the current systems in the fuel dispensing industry, a customer uses a credit card to initiate and authorize a fuel transaction. The customer card number is read by the fuel dispenser and sent back to the fuel site controller. The fuel site controller sends the credit card number to a host network through modem or other data network communications. The host computer looks up the credit card number and authorizes the fuel transaction with a message back to the site controller. Every time the customer uses the particular credit card to authorize a fuel transaction the host computer may not only authorize the card, but also look up the pre-registered information stored for that particular credit card and send a message back to the site controller indicating the customer's preferences. The site controller could provide this information to the customer automatically at the fuel dispenser without having to make any selections.

This passage shows that Terranova '464 contemplates the credit card that is being used for payment is also being used to display the customer's preferences at the fuel dispenser (such as the weather and products that the customer may want to buy). Terranova '464

fails to disclose an identification document that authorizes a fuel transaction where the identification document is unusable for payment.

From the above, it should be apparent that neither Suzuki '488 nor Terranova '464 disclose an identification document that authorizes a fuel transaction where the identification document is unusable for payment. For this reason, the rejection of claims 7 and 17 and all claims dependent therefrom using Suzuki '488 in view of Terranova '464 is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

CONCLUSION

With the above amendments and remarks, Applicant believes that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicant respectfully petitions for one month extension of time. Applicant believes that no additional fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

Date: March 16, 2006

T. Benjamin Schroeder
T. Benjamin Schroeder (Reg. No. 50,990)

KILPATRICK STOCKTON LLP
1001 West Fourth Street
Winston-Salem, North Carolina 27101-2400
Phone: (336) 607-7486
Facsimile: (336) 607-7500

50889-296804
9162086.1